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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,823	11/13/2003	Philip M. Sher	LA0093 NP	8832

7590 04/05/2005  
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EXAMINER

WARD, PAUL V

ART UNIT PAPER NUMBER

1623

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/712,823	<b>Applicant(s)</b> SHER ET AL.	
	<b>Examiner</b> PAUL V. WARD	<b>Art Unit</b> 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. The compounds according to claim 1 of formula Ib, wherein X is O. These are classifiable in class 544, subclass 123.
- II. The compounds according to claim 1 of formula Ib, wherein X is S and SO<sub>2</sub>. These are classifiable in class 544, subclass 139.
- III. The compounds according to claim 1 of formula Ib, wherein X is CHR<sup>5</sup> or CH<sub>2</sub>CHR<sup>5</sup>. These are classifiable in class 548, subclass 3.
- IV. The compounds according to claim 1 of formula Ib, wherein X is CHR<sup>5</sup>O. These are classifiable in class 540, subclass 529.
- V. The compounds according to claim 1 of formula Ib, wherein X is CHR<sup>5</sup>S. These are classifiable in class 540, subclass 133.
- VI. The compounds according to claim 1 of formula Ib, wherein X is CHR<sup>5</sup>SO<sub>2</sub>. These are classifiable in class 540, subclass 319.
- VII. The compounds according to claim 1 of formula Ib, wherein X is CHR<sup>5</sup>CO. These are classifiable in class 540, subclass 410.
- VIII. The methods of treatment, wherein X is O. The methods are classifiable in class 514.
- IX. The methods of treatment, wherein X is S and SO<sub>2</sub>. The methods are classifiable in class 514.
- X. The methods of treatment, wherein X is CHR<sup>5</sup> or CH<sub>2</sub>CHR<sup>5</sup>. The

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methods are classifiable in class 514.

XI. The methods of treatment, wherein X is  $\text{CHR}^5\text{O}$ . The methods are classifiable in class 514.

XII. The methods of treatment, wherein X is  $\text{CHR}^5\text{S}$ . The methods are classifiable in class 514.

XIII. The methods of treatment, wherein X is  $\text{CHR}^5\text{SO}_2$ . The methods are classifiable in class 514.

XIV. The methods of treatment, wherein X is  $\text{CHR}^5\text{CO}$ . The methods are classifiable in class 514.

Inventions of Group I-VII and Groups VIII-XIV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using the product such as treating hyperglycemia or diabetes.

The inventions of Groups I-XIV are separate and patentably distinct because there is no patentable co-action among them and a reference anticipating one member will not render another obvious.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classification, a search of the fourteen groups designated above

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would impose an undue burden upon the examiner, and restriction for examination purposes as indicated is proper.

A telephone call was made to Maureen O'Brien on March 29, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is requested to elect a specifically disclosed species of the invention to be examined for search purposes.

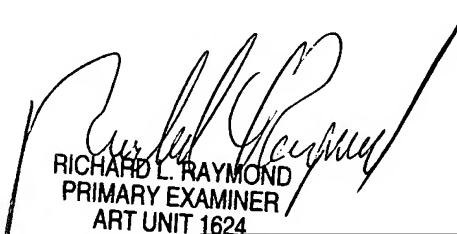
Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL V WARD whose telephone number is 571-272-2909. The examiner can normally be reached on M-F 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0642. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul V. Ward  
Patent Examiner  
Art Unit: 1621



RICHARD L. RAYMOND  
PRIMARY EXAMINER  
ART UNIT 1624

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